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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/748,084 | 12/30/2003 | Gerhard Meyer | 30882/MEY5103 | 6871 |
| 4743 | 7590 | 12/17/2008 | EXAMINER | |
| MARSHALL, GERSTEIN & BORUN LLP | | | GROUP, KARL E | |
| 233 S. WACKER DRIVE, SUITE 6300 | | | ART UNIT | PAPER NUMBER |
| SEARS TOWER | | | | 1793 |
| CHICAGO, IL 60606 | | | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 12/17/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/748,084 | MEYER ET AL. | |
| | Examiner | Art Unit | |
| | Karl E. Group | 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 November 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 62-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 62-77 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-18-08 has been entered.

Claim Interpretation

2. In view of the amendments and applicants arguments the claims are interpreted as having two phases, one having an average grain size of greater than 250 nm and the other phase having an average grain size in the range of 25 to 250 nm. The oxides phases are also different oxides, see page 6 of applicants' remarks where it is argued that the phases may be different.

Furthermore, the disclosure on page 7, lines 9 to 11, clearly discloses that "[i]t is possible to make the first metal oxide powder out of a different metal oxide than the second nanoscale metal oxide powder."

As well as the arguments on page 7,

"The claims as amended do not only require two different phases with two different grain sizes/particle sizes but actually a bimodal particle size distribution for the ceramic."

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 62-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants argue the ceramic material of the claims includes two separate phases however the claims allow for one phase with the limitation "the metal oxides are selected from one or more members". If two different phases the claim would require "two or more".

Specification

5. The following title is suggested: The title is too long and needs to be shortened.

Claim Rejections - 35 USC § 102 and 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 62-65,68-77 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nawa et al (7,012,036).

Nawa et al teach a ceramic material including zirconia grains and 20-60 volume % alumina grains. See examples 1,2,7,8,13 for average grain sizes within the claims.

The bimodal powders used as the starting material of the claimed ceramic material is not considered to patentably distinguish the claimed ceramic material because Nawa teaches the claimed grain size. With respect to claims 64,65 a stabilizer of CeO₂ is taught.

With respect to the methods used to form the powder used to form the ceramic material and the process steps used to sinter the claimed material,

“The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process.” In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

9. Claims 62-77 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 435677.

The EP document teach a sintered material including zirconia and alumina including a yttria stabilizer where examples 1,5,6 (Table 1) as well as many of the examples in table 2 have grain sizes within the claims.

The bimodal powders used as the starting material of the claimed ceramic material is not considered to patentably distinguish the claimed ceramic material because Nawa teaches the claimed grain size. With respect to claims 64,65 a stabilizer of CeO₂ is taught.

With respect to the methods used to form the powder used to form the ceramic material and the process steps used to sinter the claimed material,

In product-by-process claims, “once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference.” MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the “patentability of a product does not depend on its method of production.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. Applicants' arguments that the claims now require two different phases are persuasive in overcoming the rejections of the prior office action.

11. Watanabe et al (4,748,138) is cited for teach conventional stabilizers for zirconia. Nawa et al (5,863,850) is cited of interest for teaching alumina zirconia bodies however the grain sizes are outside the ranges claimed, see Tables.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl E. Group whose telephone number is 571-272-1368. The examiner can normally be reached on M-F (6:30-4:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karl E Group/
Primary Examiner
Art Unit 1793

Keg
12-16-08